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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,745	09/19/2003	Steven M. Menow	27087/39614	4709
4743	7590	10/20/2004	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 6300 SEARS TOWER 233 S. WACKER DRIVE CHICAGO, IL 60606			WONG, STEVEN B	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/664,745	Applicant(s) MENOW, STEVEN M. <i>CM</i>	
	Examiner Steven Wong	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-24 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 9, 13-18 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Gossard (3,624,939). Regarding claim 1, Gossard discloses a football shaped container (Figures 4-6) comprising two body parts (21, 22) that are openable to expose a display surface (26). The display surface is inherently writable and erasable.

Regarding claims 2 and 3, the container presents a compartment when opened.

Regarding claim 4, Gossard includes a hinge (23) coupling the parts together.

Regarding claim 9, the display surface of Gossard is exposed when the container is opened. The photograph provided therein is inherently capable of providing useful informational reference indicia.

Regarding claim 13, the container of Gossard is inherently capable of being used as a football.

Regarding claim 14, note the rejection of claim 1 above.

Regarding claim 15, note the rejection of claim 9.

Regarding claim 16, Gossard provides a cutout (28) that defines a compartment for receiving the display surface.

Regarding claim 17, the body part (21) is closable to cover the compartment in the other body part (22).

Regarding claim 18, note the rejections of claims 1 and 17.

Regarding claim 23, note the rejection of claim 4.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10-12, 19-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gossard (3,624,939). Regarding claims 10 and 22, it would have been obvious to one of ordinary skill in the art to form the container of Gossard from polyurethane in order to take advantage of that material's well known physical characteristics.

Regarding claims 11 and 24, Gossard teaches a spring biased hinge. It would have been obvious to one of ordinary skill in the art to have the spring be biased to the closed position in order to have the device close easier.

Regarding claim 12, the examiner takes Official Notice that latches are well known in the art of containers and to provide the container of Gossard with a latch would have been obvious to one of ordinary skill in the art in order to securely close the container.

Regarding claims 19-21, Gossard shows an alternative embodiment (Figures 7-9) where a hockey puck comprises multiple photographs that are inherently capable of being written on. The photographs are seen as plates that also provide indicia display surfaces that are mounted on the underside of the openable body section. It would have been obvious to one of ordinary skill in the art to form the football shaped container of Figures 4-6 of Gossard with the photographs

mounted on the underside of the openable body section as shown by Figures 8 and 9 in order to allow the photographs to be viewed by the user when the body sections are closed and the user is above the container.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gossard (3,624,939) as applied to claims 1 et al. above, and further in view of Stevens (5,615,883). Stevens discloses a puzzle comprising first and second frame pieces (10, 12) that are connected by a hinge (14). The hinge possesses a first plate, a second plate and a hinge base (the rod connecting the plates). It would have been obvious to one of ordinary skill in the art to provide the container of Gossard with the hinge as taught by Stevens in order to pivotably connect the body parts together.

6. Claims 1, 4, 9 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fairleigh (3,685,170) in view of Ivanek (2,163,978). Regarding claims 1, 4, 9 and 13-15, Fairleigh discloses a body comprising two body parts (11, 12) that are openable relative to one another via a hinge (15) and a display surface (26) that is exposed when the body is opened. The pad (26) writable and erasable. The indicia display surface is intended to provide useful informational reference indicia.

Ivanek discloses a hinged body that is useful for demonstrating lineups in football wherein the body is shaped as a football. It would have been obvious to one of ordinary skill in the art to form the body of Fairleigh in a football shape in order to make the device more recognizable. The body of Fairleigh when modified by Ivanek is obviously capable of being used as a football (i.e. in a game of paper football).

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Regarding claim 12, it would have been obvious to one of ordinary skill in the art to provide the device of Fairleigh with a latch in order to securely close the device when not in use.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fairleigh (3,685,170) in view of Ivanek (2,163,978) and Tout (3,181,865). Tout discloses device for use in football education comprising an opaque base layer and a liftable transparent layer. It would have been obvious to one of ordinary skill in the art to replace the pad of Fairleigh with the writable surface of Tout in order to provide a rewritable surface that does not use paper.

Allowable Subject Matter

8. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

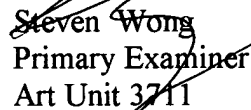
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
October 18, 2004